

**REMARKS**

In accordance with the foregoing, claims 1, 9, and 16 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-38 are pending and under consideration. Reconsideration is requested.

**REJECTION UNDER 35 U.S.C. § 102:**

*On page 3 of the Office Action, claims 1-6, 8-13, 15-20, 22, 24-26, 28-31, 33-36, and 38 were rejected under 35 USC 102(e) as being anticipated by Bence, Jr. et al. (U.S. Patent No. 6,484,178) ("Bence").*

Bence generally describes 1) viewing information about the client or office submitting a file containing data records (e.g., claims); (2) examining the submitted client data file; (3) finding a known data format that most closely matches the format of the client data file, known data formats being stored in a format database; (4) aligning the data contained in a given record, thus, creating a format corresponding to the client's data format; and (5) if the resulting format is different from all formats in the format database, saving the newly-created client format as a new known format. See column 1, line 60, to column 2, line 10. However, Bence is silent as to teaching or suggesting, "a specifying c specifying any one of the format file and the data file, and specifying the other category of file from this one file . . . wherein said specifying comprises **selecting and dragging** any one of the format file and the data file," emphasis added, as recited in independent claim 1. Nothing teaches or suggests the specifying of "any one of the format file and the data file," as recited in independent claim 1. Rather, an alignment is performed where a client's data file is compared to a data format in a given record to create a format corresponding to the client's data format.

Further, column 2, lines 35-33 of Bence generally describes a Find Closest Match module, automatically searching a known format database for a format that most closely matches the format of the data records in the client data file; and an Align Claim Data module, providing the operator with the capability of modifying the closest matching data format to create a new format matching the specific client's data record format. However, Bence fails to teach or suggest, "a setting unit **setting** the item data of the data file to the fixed format of the format file **in accordance with the specifying operation**," emphasis added, as recited in independent

claim 1.

Furthermore, column 1, lines 44-47, of Bence are referred to as providing the claimed features of the setting unit recited in independent claim 1. However, the referred portion of Bence limits to generally describe a claim formatting method and computer program product capable of accepting files in numerous formats, which may be initially unknown, and formatting them into a common format for processing. The referred portion of Bence does not describe how the claim formatting method is performed and how the computer program product is capable of accepting files in numerous formats.

Referring to independent claim 9, this claim recites, "implementing a specifying module to specify any one of the format file and the data file, and specifying the other category of file from this one file; and setting the item data of the data file to the fixed format of the format file in accordance with the specifying operation, wherein said specifying comprises selecting and dragging any one of the format file and the data file." Further, independent claim 16 recites, "implementing a specifying module for specifying any one of the format file and the data file, and specifying the other category of file from this one file; and setting the item data of the data file to the fixed format of the format file in accordance with the specifying operation, wherein said specifying comprises selecting and dragging any one of the format file and the data file." Because independent claim 1 includes similar claim features as those recited in independent claims 9 and 16, although of different scope, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 9 and 16.

**REJECTION UNDER 35 U.S.C. § 103:**

*On page 6 of the Office Action, claims 7, 14, 21, 27, 32, and 37 were rejected under 35 USC 103(a) as being unpatentable over Bence in view of Hamada et al. (U.S. Patent No. 6,191,807) ("Hamada").*

Because claims 7, 14, 21, 27, 32, and 37 depend from one of independent claims 1, 9, and 16, the combination of the cited references must teach all the claimed features recited in independent claims 1, 9, and 16. Applicant respectfully incorporates herewith the arguments previously presented supporting the patentability of independent claims 1, 9, and 16 in view of Bence. Hamada generally describes a user moving a pointing cursor 34 using a position input unit 22 to the position on an icon 33 of a file to be transferred in the file list 32. See column 5,

line 66, to column 6, line 18. Thereafter, the user depresses a button of the position input unit 22 to select the file icon 33. In this case, the CPU 21 stores information indicating that the start point of the drag & drop operation is the file icon 33, and the file name of the file. However, assuming *arguendo*, that Bence and Hamada were combined, a combination thereof would not teach or suggest, “a specifying control unit . . . a specifying control unit implementing a specifying module specifying any one of the format file and the data file, and specifying the other category of file from this one file; and a setting unit setting the item data of the data file to the fixed format of the format file in accordance with the specifying operation, wherein said specifying comprises **selecting and dragging** any one of the format file and the data file,” emphasis added, as recited in independent claim 1. As previously set forth, Bence is silent as to providing all the claimed features of the specifying control unit and the setting unit. Hamada is similarly silent as to providing those features. Rather, a drag and drop operation is provided and nothing more. Thus, a combination of Bence and Hamada would be silent as to providing all the claimed features. The combination of the cited references, for instance, would be silent as to teaching or suggesting, “wherein said specifying comprises selecting and dragging any one of the format file and the data file,” as recited in independent claim 1. Because independent claim 1 includes similar claim features as those recited in independent claims 9 and 16, although of different scope, the arguments presented above supporting the patentability of independent claim 1 are incorporated herein to support the patentability of independent claims 9 and 16.

*On page 6 of the Office Action, claim 23 was rejected under 35 USC 103(a) as being unpatentable over Bence in view of Yuichi (JP 9282209) (“Yuichi”).*

Because claim 23 depends from independent claim 1, the combination of the cited references must teach all the claimed features recited in independent claim 1. Applicant respectfully incorporates herewith the arguments previously presented supporting the patentability of independent claim 1 in view of Bence. Yuichi generally describes in a displayed definition item name list of the input file and the item name list of the specified table, respective item positions are specified, and a when a drag-and-drop operation to a desired item of the output file is performed, setting is made as the set content of the desired item, and an index expression is set from the set content. However, assuming *arguendo*, that Bence and Yuichi were combined, a combination thereof would not teach or suggest, “a specifying control unit . . . specifying the other category of file from this one file; and a setting unit setting the item data of the data file to the fixed format of the format file in accordance with the specifying operation, wherein said specifying comprises selecting and dragging any one of the format file and the data

file,” as recited in independent claim 1. As previously set forth, Bence is silent as to providing all the claimed features of the specifying control unit and the setting unit. Yuichi is similarly silent as to providing those features. Rather, definition item name list and a drag-and-drop operation is provided and nothing more. Thus, a combination of Bence and Yuichi would be silent as to providing all the claimed features. The combination of the cited references, for example, would be silent as to teaching or suggesting, “wherein said specifying comprises selecting and dragging any one of the format file and the data file,” as recited in independent claim 1.

The Office Action provides a self-serving motivation to combine the cited references. That is, conclusive statements are made such as “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine Hamada with Bence in order to save the burden of the user by allowing drag and drop instead of typing file information.” Similarly, conclusive statements are made such as “it would have been obvious to one of ordinary skill in the art at the time the invention was made to include displaying the files as a list...it will easily allow the user to locate the file when the files are displayed as a list.” However, “rejection of patent application for obviousness under 35 USC §103 must be based on evidence comprehended by language of that section, and search for and analysis of prior art includes evidence relevant to finding of whether there is teaching, motivation, or suggestion to select and combine references relied on as evidence of obviousness; factual inquiry whether to combine references must be thorough and searching, based on objective evidence of record.” In re Lee 61 USPQ2d 1430 (CA FC 2002)

Thus, as pointed out in In re Lee, the record must support motivation, i.e., there must be something in the record pointing out where the recited motivation can be found. In addition, there must be some discussion on how that purported motivation or suggestion is even relevant to the reference being modified.

Only the present invention sets forth all the claimed features, as well as the motivation for combining the same. The outstanding rejection would appear to have taken this teaching of the present invention and applied the same to generate a combination of Bence and Hamada or a combination of Bence and Yuichi, as set forth in the Office Action, to disclose the presently claimed invention. It is the Applicant's position that the prima facie burden has not been met and the obviousness rejection fails.

#### **CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding

objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance, which action is earnestly solicited.

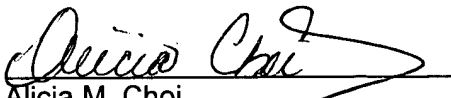
If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: 01/08/2004

By:   
Alicia M. Choi  
Registration No. 46,621

1201 New York Ave, N.W., Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501